

Application No. 08/939,050

REMARKS

In the May 18, 2004 Office Action, the Examiner rejected claims 1-10 pending in the application. Upon entry of the foregoing amendments, Applicant amends claims 1, 5 and 7 and cancels claims 2 and 6 without prejudice or disclaimer. Support for the amended claims may be found in the originally filed specification, and thus, no new matter is added by this amendment. Upon entry of the foregoing amendments, claims 1, 3-5, and 7-10 (3 independent claims; 8 total claims) remain pending in the application. Applicant requests reconsideration in view of the above amendments and the following remarks.

In the Claims

Claim Rejections

35 U.S.C. §112

Claims 1-10 stands rejected under 35 U.S.C. §112, first paragraph, "as failing to comply with the written description requirement." Specifically, the Examiner states that the "specification as originally filed has failed to teach applicant's now claimed as his invention 'knob corresponds to a user specified alphanumeric value." Applicant respectfully traverses this rejection.

With reference to the last page of the Detailed Description as filed (that is, the page before the claims), the first full paragraph of that page describes the above claimed subject matter - "knob corresponds to a user specified alphanumeric value." For example, the second to last sentence of this paragraph states "the rotary knob is rotated causing the desired value to be displayed on the display device." In the interest of speedy prosecution, Applicant has amended "user specified" to read "desired" for independent claims 1, 5 and 7. Applicants respectfully request the Examiner to remove this rejection under 35 U.S.C. §112, first paragraph for claims 1, 3-5, and 7-10.

35 U.S.C. §103

Claims 1-3, 5, 6, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA"), in view of John L. Weston, UK Patent Application, GB 2174663A (hereinafter "Weston") and Ramaswamy et al., U.S. Patent

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No. 5,627,547, issued May 6, 1997 (hereinafter "Ramaswamy"). In addition, claims 4, 7, and 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA, in view of Weston and Ramaswamy, and further in view of Aerospace Engineering (December 1994, hereinafter "Aerospace Engineering"). Applicant respectfully traverses these rejections.

Amended independent claims 1, 5, and 7 recite a rotary knob "wherein said rotary knob includes, a **coarse knob** generating coarse rotary signals indicative of rotation of said **coarse** rotary knob, and, a **fine knob** generating fine rotary signals indicative of rotating of said **fine** rotary knob." (emphasis added) The Examiner states that "it is conventional for a rotary knob to have a coarse-fine knob (see, page 6, line 22-23) as taught by Applicant's Admitted Prior Art." The Examiner further states "it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to [combine] the rotary knob of Ramaswamy et al into the device of Applicant's Admitted Prior Art, because this will allow the user to enter sequence of alphanumeric data to display aircraft / vehicle tracking information and coordinates." Applicant respectfully disagrees with the Examiner's characterization of how one would be motivated to combine Ramaswamy and the Applicant's Admitted Prior Art.

As stated in MPEP 2141, "the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**" (emphasis added) In order to establish a *prima facie* case of obviousness, "there must be some suggestion, teaching or motivation to modify the reference or combine the references on which the rejection is based." MPEP 2142. It is well established that "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). Accordingly, Office Actions rejecting claims for obviousness **must be supported by evidence**. Combining prior art references **without evidence** of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added.

Moreover, the evidence on which an obviousness rejection is based must be set forth in the Office Action. As stated in MPEP 2144.08 III, "Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35

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U.S.C. 103 ground of rejection.... Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings."

Ramaswamy generally discloses a mapless GPS navigation system for use in a vehicle. Figure 2 of Ramaswamy illustrates the face plate 12B of a navigation system 10B. The face plate includes a rotary/pushbutton 16 to sequence through various menu selections (see col. 11, lines 19-67). That is, the Ramaswamy system allows the user to use the rotary button 16 to cycle through available menu selections, but Ramaswamy does not disclose a rotary button that has a coarse knob and a fine knob. The Examiner's statement that one would "have been motivated to [combine] the rotary knob of Ramaswamy et al into the device of Applicant's Admitted Prior Art, because this will allow the user to enter sequence of alphanumeric data to display aircraft / vehicle tracking information and coordinates" does not provide evidence of how one would be motivated to combine Ramaswamy and Applicant's Admitted Prior Art as required by the MPEP as stated above.

For the above reasons, Applicant submits that each and every element of amended independent claims 1, 5 and 7 are not rendered obvious by AAPA in view of Weston and Ramaswamy or by AAPA in view of Weston and Ramaswamy and further in view of Aerospace Engineering. Therefore, Applicant respectfully requests a withdrawal to rejection of claims 1, 5, and 7 (and claims 3, 4, and 8-10 which variously depend from claims 1, 5 and 7) under 35 U.S.C. § 103(a).

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CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 1, 3-5, and 7-10, fully comply with 35 U.S.C §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. If the application is not allowed, Applicants respectfully request an **Advisory Action** from the Examiner. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Respectfully submitted,

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